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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,241	09/14/1999	CHRISTINE DUPUIS	2350-73	4909

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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT PAPER NUMBER

1617

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341,241

Applicant(s)

DUPUIS ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/24/2002, 8/23/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 24, 2002 has been entered.

Claims 15-18, 20-28 are now pending

Response to the Amendments and Arguments

2. Applicant assertion that the amended claim 15 did not require further search and consideration is noted. Examiner would point that the claims are examined based on the limitations set forth in the body of the claim, not applicant's remarks throughout the prosecution. Accordingly, the narrowing of the scope of the surfactant moiety within the body of the claim required further search and consideration after the prosecution of the application was declared closed.

Any rejection previously made that is not addressed in this Office Action is considered obviated in view of the arguments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 15-18, 20-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of the element (b) of the claim 15 is ambiguous. Element (b) of claim 15 recites the narrow range of surfactant by stating "as the sole surfactant of the composition." Further, this element recites the broad range of "at least one non-ionic surface active agent.." The recitation of a narrow limitation followed with a broad limitation that falls beyond the original narrow limitation (within the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Here, it is not clear whether the sole surfactant is a non-ionic surfactant or the sole surfactant comprise at least one non-ionic surfactant. Therefore, there is no conformity within the range of the surfactant moiety of the claimed composition. The language of the claim as recited does not limit the surfactant system of the composition to be solely consisting of non-ionic surfactants.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15-18, 20-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ha et al US Patent 5,585,104.

Ha et al disclose compositions comprising 0.01-5% acrylate crosspolymers, 0.05-20% non-ionic surfactant such as polyalkylglycosides or alkylene oxide derived non-ionic surfactants, silicon oil such as polydialkylsiloxanes, conditioning hydrocarbons such as isododecane, a suitable fragrance or other cosmetic component such as sunscreens (see col 4; col 13, col 8, lines 35-col9, line33; col 13, col 16-17, example 1-4; example 9; claims 1, 2, 5, 8, 11). All components employed by Ha are used in the same ranges as those instantly claimed. Accordingly, Ha anticipates the limitations of the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 15-18, 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almaric et al US Patent 5,670,471.

Almaric teaches preparations comprising Dodecanol at 0.3%, Tetradecanol at 1.65%, Dodecylpolyglycosides at 14.4% etc...(see col 6). Almaric further uses 4% of said concentrates in his final mixture in combination with Acrysol 22 within about 2-3 wt% of the total composition (Acrysol is a (meth)acrylic acid/ ethyl acrylate/ polyoxyethyleneated stearyl methacrylate copolymer see col 5, line 54, col 12, lines 61-67), and a conditioning agent. Almaric also teaches final compositions wherein the non-ionic surfactant alkylpolyglucoside (APG) falls within ranges of 3-4% (examples 7-11). In fact, Almaric claims preparing such final compositions wherein the 1-15% by weight of such concentrate is used (claims 26-27,31). As argued by the Applicant, Almaric does not teach the instant non-ionic type surfactants in proportion of less than 1% by weight with respect to the total weight of the composition.

However, it is well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 USPQ. 33 (CCPA 1937). In re Russell, 439 F.2nd 1228, 169 U.S.P.Q. 426 (C.C.P.A. 1971). Accordingly, absence the showing of criticality, it would have been *prima facie* obvious to optimize

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the concentration of the non-ionic surfactants used by Almeric by routine experimentation, and employ lower amounts of such surfactants, because the ordinary artisan would have had a reasonable expectation of success in improving beneficial characteristics of the his compositions such as skin tolerance and plasticity.

Conclusion

6. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

ss
November 16, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200